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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,926	09/24/2003	Jean M. Beaupre	END5009USNP	4594

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EXAMINER
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CHEN, VICTORIA W

ART UNIT	PAPER NUMBER
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3739

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/669,926	<b>Applicant(s)</b> BEAUPRE, JEAN M.	
	<b>Examiner</b> VICTORIA W. CHEN	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/1/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 15, 16 and 24 are objected to because of the following informalities:

Claim 15 recites in the preamble “an ultrasonic surgical instrument,” however the body of the claim only claims an ultrasonic blade without any other structural limitations which would make the blade useable as a surgical instrument. It is suggested that the existing preamble be deleted to form a more appropriate claim preamble of "an ultrasonic blade".

Claim 15 recites "comprising a second cross-sectional area and different from the first cross-sectional area" in ll. 5-6. It is suggested this be changed to –comprising a second cross-sectional area different from the first cross-sectional area--.

Claim 16 recites "comprising a second cross-sectional area and different from the first cross-sectional area" in ll. 10-11. It is suggested this be changed to –comprising a second cross-sectional area different from the first cross-sectional area--.

Claim 24 recites "comprising a second cross-sectional area and different from the first cross-sectional area" in ll. 4-5. It is suggested this be changed to –comprising a second cross-sectional area different from the first cross-sectional area--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 15-18, 20, 21, 24, 25 and 27 are rejected under 35 U.S.C. 102(a) as being anticipated by Okada et al. (US 6340352 B1).**

Regarding claim 15, Okada discloses an ultrasonic surgical instrument [Fig. 3] having an ultrasonic blade [143] having more than one-half wave segment [Fig. 36B] comprising a first portion [larger diameter section between both 143b sections in Fig. 36B], a second portion [143b on left] and a third portion [143b on right] wherein the first portion comprises a first cross-sectional area [Fig. 36B], the second and third portions comprise a second cross-sectional area [Fig. 36B] different from the first cross-sectional area and wherein the first portion comprises a distal end and a proximal end, the distal end connected to the second portion and the proximal end connected to the third portion [Fig. 36B], the third portion defining a first node and the second portion defining a second node, the first and second nodes defining a one-half wave segment [Fig. 36B].

Regarding claim 16, Okada discloses an ultrasonic surgical instrument [11] comprising a housing [103, Fig. 28], a tubular sheath [111] having a proximal end joined to the housing [Fig. 27], an ultrasonic waveguide [143] having an end effector [141] extending distally of the distal end of the tubular sheath [Fig. 27], the waveguide having more than one-half wave segment [Fig. 36B] comprising a first portion [larger diameter section between both 143b sections in Fig. 36B], a second portion [143b on left] and a third portion [143b on right] wherein the first portion comprises a first cross-sectional area [Fig. 36B], the second and third portions comprise a second cross-sectional area [Fig. 36B] different from the first cross-sectional area and wherein the first portion comprises a distal end and a proximal end, the distal end connected to the second portion and the proximal end connected to the third portion [Fig. 36B], the third portion defining a first

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node and the second portion defining a second node, the first and second nodes defining a one-half wave segment [Fig. 36B].

Regarding claim 17, Okada discloses a clamp arm [142] pivotally mounted on the distal end of the tubular sheath for pivotal movement with respect to the end effector.

Regarding claim 18, Okada discloses the first cross-sectional area is greater than the second cross-sectional area [Fig. 36B].

Regarding claim 20, Okada discloses the first cross-sectional area is constant [Fig. 36B].

Regarding claim 21, Okada discloses the second cross-sectional area is constant [Fig. 36B].

Regarding claim 24, see rejection of claim 15.

Regarding claim 25, see rejection of claim 18.

Regarding claim 27, see rejection of claim 20.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haibel, Jr. et al. (US 6254623 B1).**

Regarding claim 15, Haibel teaches an ultrasonic surgical instrument [Fig. 1] having an ultrasonic blade [96] having a one-half wave segment comprising a first portion [Fig. 1, 48], a second portion [50] and a third portion [46] wherein the first portion comprises a first cross-

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sectional area, the second and third portions comprise a second cross-sectional area different from the first cross-sectional area and wherein the first portion comprises a distal end and a proximal end, the distal end connected to the second portion and the proximal end connected to the third portion [Fig. 1]. Haibel also teaches the blade is capable of having more than one half wave segment [col. 4, ll. 64-66], but fails to specifically teach the third portion defining a first node and the second portion defining a second node, the first and second nodes defining a one half wave segment. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number and position of the nodes as taught by Haibel to be positioned as claimed since it was known in the art that the number and position of nodes are relative only to the vibratory frequency applied to the blade, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 16, Haibel teaches an ultrasonic surgical instrument comprising a housing [100], a tubular sheath [36] having a proximal end joined to the housing, an ultrasonic waveguide [96] having an end effector [98] extending distally of the distal end of the tubular sheath, the waveguide having a one-half wave segment comprising a first portion [Fig. 1, 48], a second portion [50] and a third portion [46] wherein the first portion comprises a first cross-sectional area, the second and third portions comprise a second cross-sectional area different from the first cross-sectional area and wherein the first portion comprises a distal end and a proximal end, the distal end connected to the second portion and the proximal end connected to the third portion [Fig. 1]. Haibel also teaches the blade is capable of having more than one half wave segment [col. 4, ll. 64-66], but fails to specifically teach the third portion defining a first

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node and the second portion defining and second node, the first and second nodes defining a one half wave segment. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number and position of the nodes as taught by Haibel to be positioned as claimed since it was known in the art that the number and position of nodes are relative only to the vibratory frequency applied to the blade, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 17, Haibel teaches a clamp arm [42] pivotally mounted on the distal end of the sheath [col. 5, ll. 55-56].

Regarding claims 18 and 22, if the first portion is now interpreted to be element 50, and the second and third portions are interpreted to be elements 98 and 48, the first cross-sectional area is now greater than the second cross-sectional area. Haibel further teaches the second cross-section is variable [see cross-section of 98, Fig. 1].

Regarding claim 19, Haibel teaches the first cross-sectional area is less than the second cross-sectional area [col. 5, ll. 29-32].

Regarding claim 20, Haibel teaches the first cross-sectional area is constant [col. 5, ll. 28-29].

Regarding claim 21, Haibel teaches the second cross-section area [here interpreted as the cross-sectional area of second portion 50] is constant [col. 5, ll. 37-38].

Regarding claim 23, Haibel teaches the second cross-sectional area is variable [col. 5, ll. 38-39].

Regarding claim 24, see rejection of claim 15.

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Regarding claim 25, if the first portion is now interpreted to be element 50, and the second and third portions are interpreted to be elements 98 and 48, the first cross-sectional area is now greater than the second cross-sectional area.

Regarding claim 26, see rejection of claim 19.

Regarding claim 27, see rejection of claim 20.

### ***Double Patenting***

Applicant is advised that should claims 15 and 18-20 be found allowable, claims 24-27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Response to Arguments***

Applicant's arguments with respect to claims 15-27 have been considered but are moot in view of the new ground(s) of rejection.

The Haibel reference has been reinterpreted to read on the claims, in addition to the Okada reference, as seen above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy D. Gibson/  
Primary Examiner, Art Unit 3739

/Victoria W Chen/  
Examiner, Art Unit 3739